

Oral Hearing:
June 16, 1998

Paper No. 23
CEW

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 7/29/99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re PI-Design AG

Serial No. 74/580,176

J. W. Gipple of Gipple & Hale for applicant.

Angela Lykos and Elizabeth Wood, Trademark Examining
Attorneys, Law Office 102 (Thomas V. Shaw, Managing
Attorney).

Before Seeherman, Hanak and Walters, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

PI-Design AG has filed a trademark application to
register on the Principal Register the mark FRENCH PRESS
for "non-electric coffee makers."¹

The Examining Attorney refused registration under
Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1),

on the ground that applicant's mark is merely descriptive of the services identified in the application. Following the Examining Attorney's final refusal to register on the ground of mere descriptiveness, applicant filed its appeal to the Board along with its request for remand and reconsideration of its amendment, proffered therewith, asserting that its applied-for mark has acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. 1052(f). In support of its claim, applicant submitted the declaration of an officer attesting to applicant's long and extensive use of the mark in the United States in connection with the identified goods since 1993; and attesting to annual sales of over \$5 million, as well as annual advertising expenditures of between approximately \$200,000 and \$1 million, both sets of figures for the years 1993 through the first 10 months of 1996. Additionally, the officer attested to applications and registrations in other countries, which are of no relevance to the issues before us; and applicant submitted samples of its advertising materials.

Following remand for consideration of applicant's claim under Section 2(f), the Trademark Examining Attorney

¹ Serial No. 74/580,176, in International Class 21, filed September 29, 1994, based on use of the mark in commerce, alleging dates of first use and first use in commerce as of September 29, 1993.

has finally refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that FRENCH PRESS, when used in connection with non-electric coffee pots, is generic and, thus, incapable of functioning as a source-identifying mark; and, further, even if FRENCH PRESS is only merely descriptive of such goods, that applicant's proof of acquired distinctiveness, under Section 2(f), is insufficient evidence of acquired distinctiveness.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, and an oral hearing was held.²

Genericness

The first question before us is whether FRENCH PRESS as used in connection with non-electric coffee pots is generic. The Examining Attorney contends that the public understands the term "French press" to be the name of a type of non-electric coffee maker, also referred to as a "plunger pot," consisting of a plunger device in a cylindrical container. In support of her position, the Examining Attorney submitted excerpts of numerous articles

² At the oral hearing applicant and the Examining Attorney stipulated that evidence submitted by the Examining Attorney with her appeal brief and at the hearing, and by applicant with its reply brief, form part of the record. Thus, we have considered this evidence.

from the LEXIS/NEXIS database; an excerpt from a book entitled *The Joy of Coffee* (Chapters Publishing Ltd. 1995); an excerpt from a dictionary; and an excerpt from *The Chicago Style Manual* (14th ed.).

Applicant contends that it owns a 70% to 80% share of the U.S. market for plunger coffee pots and, thus, "that most references in the press are to Applicant's FRENCH PRESS coffee makers, even though they are not clearly identified as such"; that the articles submitted by the Examining Attorney "do not necessarily demonstrate that the purchasing public regards FRENCH PRESS as a generic term ... [t]he articles may simply reflect improper and careless use of a trademark and public ambiguity as to the significance of the term FRENCH PRESS"; and that "plunger pot" rather than FRENCH PRESS is the generic term for the goods herein. Applicant concludes that doubts as to whether the relevant public views FRENCH PRESS as a generic term should be resolved in applicant's favor. In support of its position, applicant submitted two declarations by Ms. Ellen Wernick regarding the relevance of initial capital letters in determining whether a term is used in a trademark versus a generic manner; the declaration of acquired distinctiveness of its officer, Carsten Joergensen, attesting to sales and advertising expenditures; samples of its advertising

materials; and samples of advertising for its products in third-party publications and catalogs.

The critical issue in genericness cases is whether members of the relevant public principally use or understand the term sought to be registered to refer to the category or class of goods in question. *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 (TTAB 1992). Our primary reviewing court has set forth a two-step inquiry to determine whether a mark is generic: First, what is the category or class of goods at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that category or class of goods? *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). With respect to genericness, the Office has the burden of proving genericness by "clear evidence" thereof. *In re Merrill, Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

We find that the record clearly establishes that the category or class of goods in this case is a type of coffee maker that consists of a container in which the coffee is brewed by steeping the grounds in the water and plunging a filter device down through the water to separate out the coffee grounds. The evidence indicates that this is a

distinct method for brewing coffee and is to be distinguished from, among others, percolator, drip, or espresso methods for brewing coffee. The evidence indicates that coffee brewed in this manner in such a coffee maker has identifiable characteristics.

Turning to the second part of the test for genericness, we find that the relevant purchasing public would understand FRENCH PRESS as referring to this category or class of goods. We are not convinced otherwise by applicant's arguments to the contrary.

We find the articles excerpted by the Examining Attorney, while including references to applicant and its products, clearly use the term FRENCH PRESS to refer to a type of coffee maker and a method for brewing coffee in such a coffee maker. Following are several examples of the excerpted articles submitted by the Examining Attorney:

The best coffee comes from a **French press** - one of those contraptions that looks like a chemistry beaker topped with a plunger. ... The problem with the **French press** is that it doesn't even attempt to keep the coffee hot. [*The Denver Post*, January 15, 1997.]

... [W]hat should you give the java enthusiast on your holiday list? One possibility is a simple, elegant **French press** coffee maker. ... **French presses** are available at cookware and coffee stores for anywhere from \$20 to about \$70. The handsome 8-cup model shown, from Bodum, is \$59.99 ... AN 8-cup French press by Melior is \$29.99 at

Lechters ... [*The San Diego Union Tribune*,
November 26, 1996.]

One of the best ways to prepare a pot of coffee is the **French-press** method. ... The best **French press** I've seen is Emsa's new Aromatic Coffee Master. Unlike most presses, the Emsa unit has clear markings ... [*The Atlanta Journal and Constitution*, October 22, 1995.]

BaristaMaster claims to be the first nationally distributed espresso machine to include the **French press** option. **French press** coffee has a richer, more intense flavor than automatic drip. ... Specialty coffee houses are offering **French press** coffee. [ASAP, October 16, 1995.]

He noted that "the **French press** pot is fun to use and makes a great cup of coffee." He recommends models made by Bodum ..." [*The Courier-Journal*, November 30, 1994.]

Half the fun is all the little packages to open. Add a coffee cup, **French press** or inexpensive espresso maker as your budget allows. [*Star Tribune*, November 20, 1994.]

He says he usually does a couple cups of **French press** in the morning, then gets a couple shots of espresso during the day at work ... [*The Baltimore Sun*, October 7, 1994.]

French press. This type of coffee maker consists of a cylinder, usually glass ... As you might expect, the brew from **French presses** usually contains more sediment than drip coffee. Clean-up is messy, too. As with percolators, prices vary. You can spend as much as \$100. [*Consumer Reports*, October, 1994.]

While FRENCH PRESS occasionally appears as an adjective modifying generic nouns such as 'coffee maker' or 'brewer,' other methods for brewing coffee or types of coffee, such as "espresso," similarly appear as adjectives

modifying the larger category of goods, "coffee maker" or "brewer."

Applicant contends that the term FRENCH PRESS appears in most articles with an initial capitalized "F," i.e., "French press," and that the initial "F" in FRENCH would not be capitalized if the term were generic. Applicant contends that "in the context of shopping lists and most non-technical journalism, trademarks are used without much regard for their status." Applicant argues that in the articles submitted by the Examining Attorney "there is reflected an editorial ambiguity as to treatment of the term "FRENCH PRESS;" [however] there is a consistent tendency to set it apart from its context by use of quotation marks ("French-Press"), capitalization (FRENCH PRESS), initial capitalization (French Press), capitalization of "french" ("French press"); and that "all of these uses suggest a vague public awareness that FRENCH PRESS is other than a generic term."

In this regard, applicant submits two declarations by Ellen D. Wernick, who describes herself as "an expert on editorial use, grammar and style as practiced in U.S. publications." Referring to the 13th ed. of *A Manual of Style* (Chicago, 1982) and *The U.S. Government's Style Manual* (1984), Ms. Wernick concludes that "words derived

from geographical names are not capitalized when the term has achieved an independent common meaning (e.g., french fries, french dressing)"; and that "the capitalization of 'French' in the context of 'French press' indicates the term has not achieved an independent common meaning and is not a generic term."

We find that the Examining Attorney soundly rebuts applicant's witness' statements with both her submission of a 1994 dictionary excerpt showing an entire page of generic terms beginning with the word "French" in which the initial "F" in "French" is capitalized; and with her submission of an excerpt from the 14th edition of *The Chicago Style Manual* (1993), which includes the following statement:

Nouns, adjectives, and verbs derived from personal, national, or geographical names are often lowercased when used with a specialized meaning. According to some authorities, however, certain of these terms ought to be capitalized. Authors and editors must decide for themselves, but whatever choice is made should be followed consistently throughout a work.

Clearly, the capitalization of the initial "F" in French is not a settled matter; rather, it is a matter of individual preference.

Further, while applicant characterizes some of the evidence as demonstrating "improper or careless use" of its trademark, the real question before us is, as a result of

such use, careless or otherwise, what is the relevant public's perception of the term FRENCH PRESS in connection with the identified goods. We note that it is the careless use of a term that, over time, renders that term descriptive or generic to the relevant public. While we have no evidence from which to conclude that FRENCH PRESS was once understood as a trademark of applicant, the evidence establishes that, at this time, the relevant public will understand the term FRENCH PRESS in its generic sense, as a type of coffee maker, when considered in connection with applicant's identified goods.

Looking at the third-party advertisements for applicant's products, we note that several of these advertisements lend support to the conclusion that the term FRENCH PRESS describes a type of coffee maker. The following advertisements appear to use BODUM and BISTRO or CHAMBORD as trademarks for a type of coffee maker identified as a "French Press."

BODUM BISTRO FRENCH PRESS (below)

Simple. Reliable. Amazingly well-priced. But don't let this affordability fool you: the Bistro possesses all of the serious coffee brewing prowess of any French Press. Simply pour in the grounds, add hot water, wait four minutes (no more, no less) and push. The plunger's fine mesh screen filters downward, leaving the grounds at the bottom and you with a perfectly brewed, thickly rich cup of coffee.

**BODUM CHAMBORD
FRENCH PRESS (above)**

Of all the ways to brew coffee at home, we prefer the plunger method. The coffee is more flavorful ... no papery-filter taste in the way. Just a full-bodied, fragrant cup to enjoy. This, of course, is the Ferrari of French Presses. Stylish. Chrome-plated. Elegant and authentic.

12 cup Chambord Coffee Maker. The quality and beauty of Bodum's Chambord coffeemaker is sure to please any coffee connoisseur. French Press coffee delivers the freshest essence and is impressive for tableside service.

Finally, we are not convinced by applicant's additional argument that "plunge pot," rather than FRENCH PRESS, is the generic term available to the public. A term does not lose its generic significance simply because there are other synonymous generic expressions available for the public to use. *See, In re Gould Paper Corp.*, 5 USPQ2d 1110 (Fed. Cir. 1987).

Acquired Distinctiveness

If, ultimately, the applied for mark is found not to be generic, we would need to address the question of whether applicant has established that FRENCH PRESS has acquired distinctiveness. Therefore, in order to render a complete opinion, we consider this issue now. In this regard, applicant has provided a declaration indicating use since 1993 and sales and advertising figures, along with several advertising brochures. We note that applicant has

not provided any evidence of consumer perception.³ In view of the highly descriptive nature of the mark, we find that the evidence of record is insufficient to establish that FRENCH PRESS has acquired distinctiveness in connection with non-electric coffee makers.

Decision: The refusal to register on the ground that the mark herein is generic of the identified goods is affirmed. Alternatively, should applicant ultimately prevail on the issue of genericness, the refusal to register, under Section 2(e)(1) of the Act, on the ground that applicant's claim under Section 2(f) is insufficient evidence of acquired distinctiveness herein is affirmed.

E. J. Seeherman

E. W. Hanak

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board

³ While applicant states that it has a 70% to 80% market share for these types of coffee makers, applicant has submitted no evidence that the purchasers of such coffee makers understand FRENCH PRESS to be applicant's trademark identifying these goods.

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